

Continuation of Substance of Interview including description of the general nature of what was discussed:
In a telephone conversation with Applicant's representative, Monica De La Paz at 512-474-5201 on November 9, 2009, the Examiner informed Applicant's representative that prosecution would be re-opened per two rejections under 102(b) and one rejection under 103(a) upon review of the claimed method steps.

Upon further review of the claims submitted for Appeal, the Examiner found that:
Claims 1, 5, 7, 17 and 19 are properly rejectable under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al (1997; *of record), as evidenced by Li et al (1998; *of record in IDS) and Li et al (2001; *of record in IDS).
Claims 1, 5, 7-8, 17, 19 and 22-24 are properly rejectable under 35 U.S.C. 102(b) as being anticipated by Li et al (1998; * of record in IDS), as evidenced by Li et al (2001; *of record in IDS).

Claim 1 recites "providing a MUC1 test agent...comprising a phosphorylated YEKV site".
Both Yamamoto et al (1997) and Li et al (1998) provide a MUC1 test agent from ZR-75-1 breast carcinoma cells.
Li et al (2001) teach that in ZR-75-1 breast carcinoma cells, MUC1 is phosphorylated at the YEKV site (pg 35239, col. 2; Figures 1, 3-4).
Thus, the provided MUC1 test agent of the prior art is inherently phosphorylated at the YEKV site.

Claims 9 and 15-16 are properly rejectable under 35 U.S.C. 103(a) as being unpatentable over Li et al (1998; * of record in IDS) and Li et al (2001; *of record in IDS), as applied to Claims 1, 5, 7-8, 17, 19 and 22-24 above, and in further view of Barker et al (U.S. Patent 5,851,775).

To advance prosecution, the examiner requested an interview with Applicant's representative and Applicant to explore language to amend Claim 1 as per the specification, e.g. comparing the binding of the tumor progressor agent to MUC1 that is phosphorylated at the YEKV site versus a MUC1 test agent that is not phosphorylated at the YEKV site (pg 12, line 29; pg 40, lines 17-18; pg 41, lines 12-13; pg 45, lines 13-15). An amendment to Claim 1 that reflects such a comparison may overcome the prior art of record.

In a telephone conversation with Applicant's representative on November 18, 2009, Applicant's representative suggested the following amendment to Claim 1, step (b):
"providing a tumor progressor test agent that has increased binding to the phosphorylated MUC1 test agent as compared to a MUC1 test agent that does not comprise a phosphorylated YEKV site", so as to distinguish Applicant's method over the prior art. (See, e.g., Examples 3 and 11).

Applicant's representative has authorized the Examiner to make said amendment to the present claims via Examiner's amendment.